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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,585	12/22/2000	Christoph T. Corvin	GEMS:0124/yod 15-EC-5765	2672
7590 05/05/2005 Patrick S. Yoder Suite 330 7915 FM 1960 West Houston, TX 77070			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,585

Applicant(s)

CORVIN, CHRISTOPH T.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 26-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This is in response to Applicants' communication dated December 28, 2004. Election of claims 1-25 with traverse by the Applicants is acknowledged. Arguments with regards to restriction/election are addressed below. Elected claims 1-25 have been examined. The rejections are stated below.

Response to Arguments regarding Restriction/Election

2. With respect to groupings of claims the reasons for restricting the claims into the categories have been presented in the last office action. However for the sake of clarity the following additional information is presented. The difference between a method and a system is akin to the difference between a process and an apparatus. As mentioned in the last office action the methods can be performed by a system configuration different from what is claimed in invention II. A utility of invention I is analyzing the client data with the investment analysis system, wherein the client data comprises financial data relating to a desired capital investment in medical resources for the medical facility whereas a utility of invention III is obtaining a financial analysis of a capital investment from a financial analysis system, the financial analysis comprising an evaluation of projected revenues and expenses relating to expected changes from implementing the capital investment. A utility of invention IV is investment analysis using projected financial statistics relating to changes in medical procedures expected from implementing a capital investment. Clearly the utilities of the three inventions (I, III and IV) are different from one another.

Even though all the groupings are classified in the same class and subclass, the inventions are separate as discussed in the last office action. Business methods being a relatively new

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technology from the standpoint of patents, several separate subcategories are grouped together in the same subclass even though one with ordinary skill in the art would clearly delineate these subcategories as warranting separate subclasses. Hence different fields of search are warranted. Unlike other art units, in Business methods a significant amount of the search is in non-patent literature. The statement by the applicants that "search and examination of the entire application can be made without serious burden" is not a test of "serious burden" imposed on the examiner.

Accordingly the Examiner maintains the restriction of claims made in the last office action. Claims 26-67 are withdrawn from consideration as being drawn to the non-elected group. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eder (US Patent 6,321,205 B1) in view of Hosios et al (Reference U).

With reference to claim 1, Eder teaches a method for analyzing a capital investment, the method comprising: providing access to an investment analysis system via a network (See Eder Column 9 lines 5-10); providing a network interface for communication with the investment analysis system, the network interface comprising a form for transmitting client data to the investment analysis system (See Eder Column 9 lines 5-50 and Column

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8 lines 13-21); analyzing the client data with the investment analysis system, wherein the client data comprises financial data (See Eder Figure 8, Column 7 lines 29-31 and Column 11 line 64 – Column 12 line 30); generating an investment analysis report of the desired capital investment, wherein the investment analysis report is tailored to the client data (See Eder Figures 14-16, Column 7 lines 50-62 and Column 45 lines 13-41); and transmitting the investment analysis report to a client via the network (See Eder Column 8 lines 15-21 and Column 46 line 61 – Column 47 line 8).

Eder fails to teach the step wherein the capital investment is in medical resources for a medical facility and data comprises data relating to a desired capital investment in medical resources for the medical facility.

Hosios teaches the step wherein the capital investment is in medical resources for a medical facility (See Hosios Abstract) and data comprises data relating to a desired capital investment in medical resources for the medical facility (See Hosios Pages 210-214).

Both Eder and Hosios are concerned with providing information in relation to capital investments. It would have been obvious to one with ordinary skill in the art at the time of the current invention to modify the invention of Eder to include the teaching of Hosios. The combination of the disclosures taken as a whole suggests that investors in the medical system would have benefited from the systematic analysis provided by the combination.

With reference to claims 2-9 and 15-25, Eder teaches the steps of coupling the investment analysis system to the Internet (See Eder Column 8 lines 11-13); storing at least a portion of the client data, and tailoring the form for the client according to the

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portion of client data (See Eder Column 8 lines 11-30); receiving the client data from the network interface at the investment analysis system via the network (See Eder Column 9 lines 5-40); receiving an investment cost for the desired capital investment; receiving a financing amount for the desired capital investment (See Eder Column 3 lines 7-9 and Column 23 lines 13-15); receiving financing terms for the desired capital investment (See Eder Column 22 lines 20-50) including receiving an interest rate (See Eder Column 23 lines 5-10); receiving an internal discount rate set by the client for evaluating investment acceptability (See Eder Column 22 line 65 – Column 23 line 20, the cost of capital is the internal discount rate); receiving a projected inflation rate (old and well known); receiving a projected revenue generated by implementing the desired capital investment (See Eder Column 19 line 55 – Column 22 line 7 and Column 35 line 64 – Column 37 line 15); comprising receiving a projected revenue lost by implementing the desired capital investment (See Eder Column 19 line 55 – Column 22 line 7 and Column 35 line 64 – Column 37 line 15); receiving a projected revenue deduction relating to the desired capital investment; receiving a desired timing for implementing the desired capital investment (See Eder Column 19 line 55 – Column 22 line 7 and Column 35 line 64 – Column 37 line 15); receiving a projected value of existing resources to be replaced by the desired capital investment (See Eder Column 11 lines 17-21, changes in capital requirements are interpreted to include projected value of existing resources to be replaced by the desired capital investment); receiving projected tax data for the enterprise (See Eder Column 22 lines 8-12 and Column 23 lines 5-10); generating an investment analysis report comprises generating pro forma financial statements tailored to the client data (See Eder Column 13 lines 49-62);

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generating an investment analysis report comprises generating a discounted cash flow analysis report (See Eder Column 10 lines 45-50); generating a discounted cash flow analysis report comprises generating a net present value analysis report (old and well known); and generating a discounted cash flow analysis report comprises comparing a plurality of the desired capital investments (old and well known).

With reference to claims 10-14, Hosios teaches the steps of receiving medical procedure statistics expected to be changed by implementing the desired capital investment; receiving projected statistics for a new medical procedure generated by the desired capital investment; receiving projected statistics for a lost medical procedure from implementing the desired capital investment; receiving a projected mix of payor types for a medical procedure; and receiving the projected mix for inpatients and outpatients at the medical facility (See Hosios pages 210-214)

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Watson (US Patent 6,581,0145 B1) (June 17, 2003) Asset Management System for Analyzing the Condition of Assets and Evaluating Repair/replacement Options.

(b) Sandretto (US Patent 5,812, 988) Method and system for Jointly Estimating Cash Flows, Simulated returns, risk Measures and Present Values for a Plurality of Assets.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to

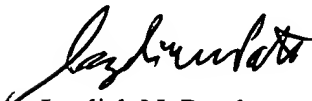
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7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax phone number for the Patent Office where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian

April 30, 2005



Jagdish N. Patel
Primary Examiner